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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,359	10/03/2001	Christopher Jensen Read	SNY-R4742	1702
24337	7590	11/01/2006	EXAMINER	
MILLER PATENT SERVICES 2500 DOCKERY LANE RALEIGH, NC 27606			SHIBRU, HELEN	
			ART UNIT	PAPER NUMBER
			2621	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/970,359	<b>Applicant(s)</b> READ, CHRISTOPHER JENSEN	
	<b>Examiner</b> HELEN SHIBRU	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7-10, 12-16, 18, 20-23, 25-45 and 54-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-3,5,7-10,12-16,18,20-23,25-45 and 54-68.

### **DETAILED ACTION**

1. Applicant's response filed on 10/06/2006 has been made of record and claims 4, 6, 11, 17, 19, 24, and 46-53 are hereby withdrawn from further consideration as being drawn to a nonelected species.

Applicant states in page 2 that "in view of the additional cost of prosecuting two applications and the minimal relief of examination burden by virtue of the present election, Applicant further requests reconsideration and removal of the election requirement, and examination of all claims on their merits."

The Examiner respectfully disagrees. The following inventions are independent or distinct for the reasons given below and there would be a serious burden on the Examiner if restriction is not required. Therefore based on the elected claims further restriction is hereby given.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 27-31, 32-36, 1-3, 5, 7-10, and 12-13, drawn to a personal video recorder device, comprising "a tuner receiving a video signal input and producing a live video signal as an output...a controller that directs the switch to provide one of the live video signal and the analog video signal to the output circuit; and wherein the controller receives user commands and responsive to a user command to change a channel, commands the switch to route the live video signal to the output circuit", classified in class 725, subclass 141.

- II. Claims 37-41, 14-16, 18, 20-23, and 25-26, drawn to a personal video recorder device, comprising “ a tuner receiving a video signal input and producing a live video signal as an output...a controller that directs the switch to route one of the digital live video signal and the stored digital video signal to the digital to analog converter; and wherein the controller receives user commands and responsive to a user command to implement an effect using the disk drive, the controller commands the switch to route the stored digital video signal to the digital to analog converter”, classified in class 386, subclass 68.
- III. Claims 54-57 and 58-60, drawn to a method of controlling operation of a personal video recorder comprising “ receiving an input signal from a video source... if a channel change command has not been issued, selecting the source of the output to be from a source prior to the hard disk drive so that the source of the output signal is not delayed by storage to and retrieval from the hard disk”, classified in class 725, subclass 58.
- IV. Claims 61-64, drawn to a method of controlling operation of a personal video recorder, comprising “ a tuner, receiving an input signal containing television programming...receiving a channel change command, and in response thereto presenting a representation of the television programming received at the tuner to the output without the storing and retrieving”, classified in class 725, subclass 93.
- V. Claims 65-68, drawn to a method of controlling operation of a personal video recorder, comprising “ a tuner, receiving an input signal containing television programming...receiving an effect command in response thereto retrieving the

digital representation from the storage medium and presenting the retrieved digital representation to the output as delayed video”, classified in class 725 subclass 116.

- VI. Claims 42-45, drawn to a personal video recording device comprising “input circuit receiving a video signal input and producing a live video signal as an output...wherein the control means receives user commands and responsive to a user command operates the switching means in one of a live video output mode and delayed video output mode, wherein in the delayed video output mode the switching means routes a signal to the output circuit by retrieving of the stored video signal and wherein in the live video output mode the switching means routes a signal to the output circuit without storage and retrieval in the disk drive”, classified in class 386, subclass 92.

The inventions are distinct, each from the other because of the following reasons:

3. Group I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the personal video recorder device as claimed in claims 27 and 32 does not require the feature of “the controller receives user commands and responsive to a user command to implement an effect using the disk drive, the controller commands the switch to route the stored digital video signal to the digital to analog converter” as claimed in claim 37 of group II.

4. Group IV and group V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the personal video recorder device as claimed in claim 61 of group IV does not require the feature of “receiving an effect command in response thereto retrieving the digital representation from the storage medium and presenting the retrieved digital representation to the output as delayed video” as claimed in claim 65 of group V.

“The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

5. Moreover the personal video recorder device as claimed in claim 27 and 32 of Group I does not require the features of “if a channel change command has not been issued, selecting the source of the output to be from a source prior to the hard disk drive so that the source of the output signal is not delayed by storage to and retrieval from the hard disk” as claimed in claim 54 and 58 of group III, “receiving a channel change command, and in response thereto presenting a representation of the television programming received at the tuner to the output without the

storing and retrieving” as claimed in claim 61 of group IV, “receiving an effect command in response thereto retrieving the digital representation from the storage medium and presenting the retrieved digital representation to the output as delayed video” as claimed in claim 65 of group V, and “wherein the control means receives user commands and responsive to a user command operates the switching means in one of a live video output mode and delayed video output mode, wherein in the delayed video output mode the switching means routes a signal to the output circuit by retrieving of the stored video signal and wherein in the live video output mode the switching means routes a signal to the output circuit without storage and retrieval in the disk drive” as claimed in claim 42 of group VI.

Furthermore the method of controlling operation of a personal video recorder as claimed in claims 54 and 58 of group III does not require the features of “a controller that directs the switch to provide one of the live video signal and the analog video signal to the output circuit; and wherein the controller receives user commands and responsive to a user command to change a channel, commands the switch to route the live video signal to the output circuit” as claimed in claims 27 and 32 of group I, “the controller receives user commands and responsive to a user command to implement an effect using the disk drive, the controller commands the switch to route the stored digital video signal to the digital to analog converter” as claimed in claim 37 of group II, “receiving a channel change command, and in response thereto presenting a representation of the television programming received at the tuner to the output without the storing and retrieving” as claimed in claim 61 of group IV, “receiving an effect command in response thereto retrieving the digital representation from the storage medium and presenting the retrieved digital representation to the output as delayed video” as claimed in claim 65 of group



V, and “wherein the control means receives user commands and responsive to a user command operates the switching means in one of a live video output mode and delayed video output mode, wherein in the delayed video output mode the switching means routes a signal to the output circuit by retrieving of the stored video signal and wherein in the live video output mode the switching means routes a signal to the output circuit without storage and retrieval in the disk drive” as claimed in claim 42 of group VI.

In addition the method of controlling operation of a personal video recorder as claimed in claim 61 of group IV does not require the features of “a controller that directs the switch to provide one of the live video signal and the analog video signal to the output circuit; and wherein the controller receives user commands and responsive to a user command to change a channel, commands the switch to route the live video signal to the output circuit” as claimed in claims 27 and 32 of group I, “the controller receives user commands and responsive to a user command to implement an effect using the disk drive, the controller commands the switch to route the stored digital video signal to the digital to analog converter” as claimed in claim 37 of group II, “receiving an input signal from a video source... if a channel change command has not been issued, selecting the source of the output to be from a source prior to the hard disk drive so that the source of the output signal is not delayed by storage to and retrieval from the hard disk” as claimed in claims 54 and 58 of group III.

Furthermore the personal video recording device as claimed in claim 37 of group II does not require the features of “if a channel change command has not been issued, selecting the source of the output to be from a source prior to the hard disk drive so that the source of the output signal is not delayed by storage to and retrieval from the hard disk” as claimed in claim 54

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and 58 of group III, “receiving a channel change command, and in response thereto presenting a representation of the television programming received at the tuner to the output without the storing and retrieving” as claimed in claim 61 of group IV, “receiving an effect command in response thereto retrieving the digital representation from the storage medium and presenting the retrieved digital representation to the output as delayed video” as claimed in claim 65 of group V, and “wherein the control means receives user commands and responsive to a user command operates the switching means in one of a live video output mode and delayed video output mode, wherein in the delayed video output mode the switching means routes a signal to the output circuit by retrieving of the stored video signal and wherein in the live video output mode the switching means routes a signal to the output circuit without storage and retrieval in the disk drive” as claimed in claim 42 of group VI.

In addition the personal video recorder device as claimed in claim 42 of group VI does not require the features of “a controller that directs the switch to provide one of the live video signal and the analog video signal to the output circuit; and wherein the controller receives user commands and responsive to a user command to change a channel, commands the switch to route the live video signal to the output circuit” as claimed in claims 27 and 32 of group I, “the controller receives user commands and responsive to a user command to implement an effect using the disk drive, the controller commands the switch to route the stored digital video signal to the digital to analog converter” as claimed in claim 37 of group II, and “if a channel change command has not been issued, selecting the source of the output to be from a source prior to the hard disk drive so that the source of the output signal is not delayed by storage to and retrieval from the hard disk” as claimed in claim 54 and 58 of group III.

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6. Claim 42 link(s) claim 61 of group IV inventions and Claim 65 of group V invention.

The restriction requirement among the linked inventions is **subject to** the nonallowance of the linking claim(s), claims 61-64 and claims 65-68. Upon the indication of allowability of the

linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and

any claim(s) depending from or otherwise requiring all the limitations of the allowable linking

claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104

**Claims that require all the limitations of an allowable linking claim** will be entered as a

matter of right if the amendment is presented prior to final rejection or allowance, whichever is

earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments

submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

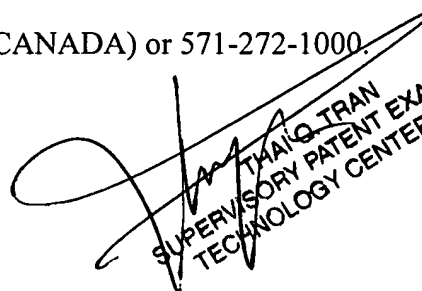
8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
THAI Q. TRAN  
SUPERVISORY PATENT EXAMINER  
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